

ESTTA Tracking number: **ESTTA188138**

Filing date: **01/23/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Ferrari S.p.A,
Granted to Date of previous extension	01/23/2008
Address	Via Emilia Est 1163 Modena, 41100 ITALY

Attorney information	Albert Robin Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036-6799 UNITED STATES trademark@cll.com, rxl@cll.com Phone:212-790-9200
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Applicant Information

Application No	78781037	Publication date	09/25/2007
Opposition Filing Date	01/23/2008	Opposition Period Ends	01/23/2008
Applicant	FERRARI EXPRESS 215 MILL STREET LAWRENCE, NY 11559 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 1990/07/10 First Use In Commerce: 1990/07/10 All goods and services in the class are opposed, namely: Customs clearance services in relation to the preparation of appropriate paperwork and transportation documentation for others in the field of jewelry, gems, precious metals, fashion accessories and watches; logistics services, namely, arranging the collection, pick-up, storage, transportation, security packing, and distribution of goods for others by air, rail, ship and/or truck in the field of jewelry, gems, precious metals, fashion accessories and watches
Class 036. First Use: 1990/07/10 First Use In Commerce: 1990/07/10 All goods and services in the class are opposed, namely: Customs brokerage services in the field of jewelry, gems, precious metals, fashion accessories and watches
Class 039. First Use: 1990/07/10 First Use In Commerce: 1990/07/10 All goods and services in the class are opposed, namely: Transportation services, namely, freight forwarding of cargo by air, rail, ship and/or truck in the field of jewelry, gems, precious metals, fashion accessories and watches; shipping of goods by air, rail, ship and/or truck in the field of jewelry, gems, precious metals, fashion accessories and watches; transport of goods by armored and non-armored vehicles in the field of jewelry, gems, precious metals, fashion accessories and watches; warehouse storage in the field of jewelry, gems, precious metals, fashion accessories and watches; rental of

warehouse space in the field of jewelry, gems, precious metals, fashion accessories and watches; security packing for high value goods for transportation in the field of jewelry, gems, precious metals, fashion accessories and watches; distribution services, namely delivery of goods for others in the field of jewelry, gems, precious metals, fashion accessories and watches

Grounds for Opposition

Other	see attached correspondence
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Attachments	FERRARIEXPRESSnoo.PDF (6 pages)(27598 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Albert Robin/
Name	Albert Robin
Date	01/23/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application No. 78781037
Published in the Official Gazette of September 25, 2007

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FERRARI S.p.A.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.
FERRARI EXPRESS,	:	
	:	
Applicant.	:	

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NOTICE OF OPPOSITION

Ferrari S.p.A., an Italian joint stock company, with offices at Via Emilia Est 1163, 41100 Modena, Italy (hereinafter referred to as “Opposer”) believes it is or will be damaged by registration of the mark shown in Application Serial No. 78/781037 and hereby opposes the same.

As grounds of opposition it is alleged that:

1. Opposer is informed and believes and therefore avers that Ferrari Express (hereinafter referred to as “Applicant”) is a New York corporation with an address at 215 Mill Street, Lawrence, New York 11559.

2. Applicant is not now and never was entitled to appropriate or register as a trademark the designation FERRARI EXPRESS for which it seeks registration in Application Serial No. 78/781037, published in the Official Gazette of September 25, 2007 for the services set forth therein.

3. Applicant was not entitled to appropriate or register as a trademark the designation FERRARI EXPRESS either on July 10, 1990, the claimed date of first use thereof, or on December 27, 2005, the date of the filing of its application for registration thereof, or on September 25, 2007, the date of the publication for opposition thereof in the Official Gazette.

4. For many years, Opposer has been engaged in manufacturing and having manufactured for it high performance automobiles and parts and accessories and other items which are advertised, offered for sale and sold in the United States and elsewhere under Opposer's trademark FERRARI and trademarks, which are comprised of FERRARI together with other words, symbols or devices (hereinafter "the FERRARI Trademark").

5. For many years, licensees of Opposer have been manufacturing items of various descriptions which are advertised, offered for sale and sold in the United States and elsewhere under the FERRARI trademark.

6. Opposer is the owner of a number of registrations of the FERRARI Trademark issued by the United States Patent and Trademark Office.

7. For many years, Opposer and its authorized dealers and other licensees have been using the service mark FERRARI and service marks which are comprised of FERRARI together with other words, symbols and devices (hereinafter the "FERRARI Service Mark") in connection with the rendering of various services including repair and maintenance of automobiles, transportation of automobiles to and from FERRARI dealers and owners and to and from automobile races, meets and exhibitions, retail services rendered both in retail establishments and on-line, and others.

8. Opposer is the owner of a number of registrations of the FERRARI Service Mark issued by the United States Patent and Trademark Office.

9. Among the FERRARI Trademarks and FERRARI Service Marks which FERRARI has registered in the United States Patent and Trademark Office are the trademark and service mark FERRARI, the trademark FERRARI ENGINEERING, the service mark FERRARI SHOP, the service mark FERRARI STORE and the trademark and service mark FERRARI WORLD.

10. In Application Serial No. 78/781037 Applicant seeks to register the designation FERRARI EXPRESS for customs clearance services in relation to the preparation of appropriate paperwork and transportation documentation for others in the field of jewelry, gems, precious metals, fashion accessories and watches; logistics services, namely, arranging the collection, pick-up, storage, transportation, security packing, and distribution of goods for others by air, rail, ship and/or truck in the field of jewelry, gems, precious metals, fashion accessories and watches, in International Class 35, customs brokerage services in the field of jewelry, gems, precious metals, fashion accessories and watches, in International Class 36, and transportation services, namely, freight forwarding of cargo by air, rail, ship and/or truck in the field of jewelry, gems, precious metals, fashion accessories and watches; shipping of goods by air, rail, ship and/or truck in the field of jewelry, gems, precious metals, fashion accessories and watches; transport of goods by armored and non-armored vehicles in the field of jewelry, gems, precious metals, fashion accessories and watches; warehouse storage in the field of jewelry, gems, precious metals, fashion accessories and watches; rental of warehouse space in the field of jewelry, gems, precious metals, fashion accessories and watches; security packing for high value goods for transportation in the field of jewelry, gems, precious metals, fashion accessories and watches; distribution services, namely delivery of goods for others in the field of jewelry, gems, precious metals, fashion accessories and watches, in International Class 39.

GROUND I

11. Opposer repeats and reavers the averments of Paragraphs 1 through 10, inclusive, of this Notice of Opposition.

12. FERRARI EXPRESS, as sought to be registered by Applicant so resembles the FERRARI Trademark and the FERRARI Service Mark, as used and registered by Opposer, as to be likely to cause confusion, or to cause mistake or to deceive.

GROUND TWO

13. Opposer repeats and reavers the averments of Paragraphs 1 through 10, inclusive, of this Notice of Opposition.

14. Opposer has used FERRARI as a corporate name, trade name, trademark and service mark for more than sixty years.

15. Opposer has widely advertised and promoted FERRARI as a corporate name, trade name, trademark, and service mark.

16. As a result of the matters alleged in paragraphs 14 and 15, above, Opposer's FERRARI name and mark had become, prior to the claimed first use date in Application Serial No. 78/781037, and now is famous.

17. Use of the designation FERRARI EXPRESS by Applicant in connection with the services covered by Application Serial No. 78/781037 is likely to cause dilution by blurring.

WHEREFORE, Opposer prays that Application Serial No. 78/781037 be rejected, and that registration of the designation FERRARI EXPRESS as a service mark to Applicant be refused and denied.

Applicant hereby appoints Albert Robin and all other attorneys of Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, NY 10036, attorneys at law, to act as

its attorneys in the above-identified opposition, to prosecute this opposition, to transact all business in the United States Patent and Trademark Office and the United States Courts in connection with said opposition, and to sign their names to all documents which may hereinafter be filed in connection with said opposition and to receive all official communications relating to the same.

Please direct all correspondence to Albert Robin.

Dated: New York, New York
January 23, 2008

COWAN, LIEBOWITZ & LATMAN, P.C.

By /s/ Albert Robin
Albert Robin
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

Attorneys for Opposer

Certificate of Service

A copy of the foregoing Notice of Opposition was served upon Applicant by sending a copy by first-class mail, postage prepaid, addressed to Frank Ferrante, Ferrante, PLLC, 5 West 19th Street, Floor 10, New York, New York 10011-4216, this 23rd day of January, 2008.

/s/ Albert Robin
Albert Robin